

**REMARKS**

Claim 21-27 were pending in the present application. Claims 21-27 have been canceled without prejudice to the subject matter provided therein. Claims 28-40 have been added by this amendment. Applicants submit that these changes do not include any new matter. Favorable reconsideration of the application and allowance of all of the pending claims are respectfully requested in view of these amendments and the following remarks.

***35 U.S.C. § 112, first paragraph***

The final office action dated March 22, 2007, rejected claims 21, 24 and 27 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Applicants have cancelled claims 21-27 and replaced them with new claims 28-40. Applicants respectfully submit that new claims 28-40 are in compliance with 35 U.S.C. § 112, first paragraph. Applicants therefore respectfully request the withdrawal of this 35 U.S.C. § 112, first paragraph rejection.

***35 U.S.C. § 112, second paragraph***

The final office action dated March 22, 2007, rejected claim 21 under 35 U.S.C. § 112, second paragraph, as being indefinite. This 35 U.S.C. § 112, second paragraph rejection was withdrawn in the Examiner's Answer dated December 11, 2007. Applicants have cancelled claims 21-27 and replaced them with new claims 28-40. Applicants respectfully submit that new claims 28-40 are in compliance with 35 U.S.C. § 112, second paragraph.

***35 U.S.C. § 102(e)***

The final office action dated March 22, 2007, rejected claim 21 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2005/0054969 to Hoff. Applicants have cancelled claims 21-27 and replaced them with new claims 28-40. Applicants respectfully submit that new claims 28-40 are not anticipated by Hoff.

Each of new claim 28 calls for, *inter alia*, “a selectively conducting electrode material having a first side in electrical contact with the 2D array of unit cells of the electronic array and a second side opposite the first side, wherein the second side of the conducting electrode material is suitable for plating a monolayer of cells or lipid vesicles to be electroporated; and

a fluid chamber defined by the second side of the conducting electrode material, a top disposed opposite the second side of the conducting electrode material and at least one sidewall separating the second side of the conducting electrode material and the top.”

Hoff does not teach each and every feature of claim 28. For example, Hoff does not teach “a fluid chamber defined by the second side of the conducting electrode material.” If at all, Hoff teaches only “a microplunger 17 having a lumen 18 through which a substance may be forced towards the base's distal face.” (See paragraph [0049].)

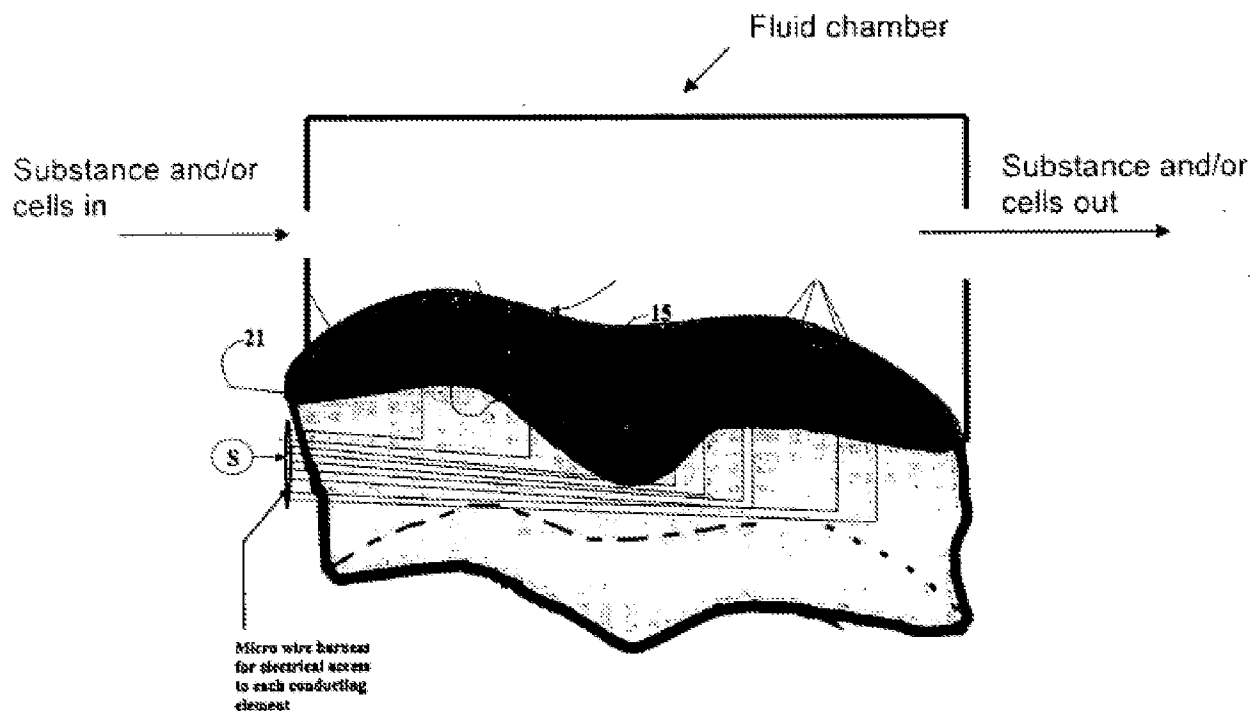
Since Hoff does not teach each and every feature of claim 28, claim 28 is not anticipated by Hoff. Claims 27-39 depend from and add additional features to claim 28, and thus are patentable for at least the same reasons as claim 28. Applicants therefore respectfully request the withdrawal of this 35 U.S.C. § 102(e) rejection.

### ***35 U.S.C. § 103(a)***

The final office action dated March 22, 2007, rejected claims 21 and 23-27 under 35 U.S.C. § 103(a) as being obvious over Hoff in view of U.S. Patent Application Publication No. 2006/0206161 to Nicolelis and/or in view of U.S. Patent Application Publication No. 2004/0197883 to Dzekunov. Likewise, the final office action dated March 22, 2007, also rejected claim 22 under 35 U.S.C. § 103(a) as being obvious over Hoff in view of Nicolelis and/or Dzekunov and further in view of U.S. Patent Application Publication No. 2004/0241965 to Merritt.

Applicants have cancelled claims 21-27 and replaced them with new claims 28-40. Applicants respectfully submit that new claims 28-40 are not obvious over Hoff in view of Nicolelis and/or Dzekunov.

Neither Nicolelis nor Dzekunov teach the deficiencies of Hoff. For example, Nicolelis does not teach a fluid chamber at all. Further, the teachings of Hoff preclude combining the teachings of Hoff with the fluid chamber taught by Dzekunov, as suggested. In particular, the Examiner's Amendment suggests the following as a possible figure describing how Hoff may be modified by Dzekunov.



This arrangement would render Hoff inoperable for its intended use. Hoff is specifically designed such that the array base contacts a target tissue in vivo, such as skin, an internal organ, or a tumor. (See, e.g., paragraphs [0021] and [0036].) Paragraph [0044] describes possible configurations for the array base as follows.

An exemplary array base 12 comprises a substantially planar structure that may be laid upon a surface of a target tissue T. Another comprises a tape-like structure that may be placed in surrounding relation to a tube-like tissue T such as, but not limited to, a vessel, nerve, or gastrointestinal component. A third comprises an array structure that is wrapped around a balloon like substrate and inserted within the treatment tissue site so that the balloon and structure can expand and conform to the inner margin of the treatment site. It is also envisioned that the extent of expansion may vary with respect to treatment time and duration.

As such, adding a fluid chamber, as suggested would effectively block the array base from contacting any target tissue in vivo. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959); MPEP §2143.01.

Therefore, Applicants submit that claim 28 are not obvious over Hoff in view of Nicoletis and/or Dzekunov. Claims 27-39 depend from and add additional features to claim 28, and thus are patentable for at least the same reasons as claim 28. Applicants therefore respectfully request the withdrawal of these 35 U.S.C. § 103(a) rejection.

#### CONCLUSION

Applicants believe that the above constitutes a full and complete reply and that the stated grounds for rejection have been properly traversed, accommodated or rendered moot. In view of the above amendments and remarks, Applicants believes the pending application is in condition for allowance. Applicants respectfully request that the Examiner reconsider and promptly withdraw the outstanding objections and rejections. The Examiner is invited to contact the undersigned for any reason so as to expedite the examination of this application.

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Respectfully submitted,

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